Applicant : Schwarze, et al.   Attorney's Docket No.: 13914-025001/2003P00070 US
Serial No. : 10/669,893
Filed   : September 23, 2003
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REMARKS

Applicants thank the Examiner for initiating the telephone interview on June 26, 2007. The Examiner said regarding claim 12 that the recitation to proxy settings would not be obvious in view of the secondary reference if there was an additional recitation in the claim of the context in which the functions operated (namely, on a server, or a separate server). Moreover , the Examiner also referred to claim 25, pointing out that that claim doesn't say that it's on a server. No agreement was reached.

In the Action mailed June 22, 2007, the Examiner rejected all pending claims 1-35. In reply, Applicants have amended claims 1, 5, 10, 12, 13, 17, 23, 24, 29, and 35. This includes claims 1, 13, and 24, which are independent claims. Applicants request consideration of the claims as amended in view of the following remarks. Submitted together with this response is an information disclosure statement.

Independent claim 1 is being amended to recite a method in which the plurality of catalog servers and catalog items contained therein are provided and maintained by at least one external vendor and where catalog items are identified in response to the request by a search performed by the corresponding catalog server. The amendment is supported by the present disclosure, for example in the description "The catalog servers 105 may be provided by multiple external vendors. A catalog server may include a catalog database 140 that stores information regarding available products and services, and a catalog application 145 that searches the catalog database based on a request and compiles and returns results based on the request" on page 5-6 lines 23-4. Independent claims 13 and 24 are similarly amended.

Dependent claim 5 is being amended to address the issue raised by the Examiner. The amendment is supported by the present disclosure, for example by claim 5 as originally filed. Dependent claims 17 and 29 are similarly amended.

Dependent claim 12 is being amended to recite a method in which determining comprises a determination by an application server of available catalog servers from proxy settings of a browser used by the requestor. The amendment is supported by the present disclosure, for example in the description "The application server may include a search agent 135" on page 5,

lines 3-4 and "The search agent may determine catalog servers accessible to a particular user for electronic purchases from the user's web browser proxy settings" on page 10, lines 1-4. Dependent claims 23 and 35 are similarly amended.

Generally, the expression "one or more …" in the claims is being amended to read "at least one …". This is accompanied by a change of the associated noun from a plural form to a singular form (e.g., from "catalog items" to "catalog item"). This amendment is supported by the previous language being amended, and by the disclosure as a whole.

No new matter is added.

Claim Rejections – 35 U.S.C § 103

The Examiner rejected pending claims 1, 4, 5, 7-11, 13, 16, 18-22, 24, 25, 28, and 30-33 under 35 U.S.C § 103(a) as being unpatentable over Dorobek ("Group Demos Way to Shop Multiple E-Catalogs") in view of official notice. The Examiner rejected pending claims 2, 5, 14, 17, 26, and 29 under 35 U.S.C § 103(a) as being unpatentable over Dorobek in view of Van Etten et al. (U.S. Patent 7,047,211). The Examiner rejected pending claims 3, 15, and 27 under 35 U.S.C § 103(a) as being unpatentable over Dorobek in view of Dan et al. (U.S. Patent Application Publication 2002/0138370). The examiner rejected pending claims 12, 23, and 35 under 35 U.S.C § 103(a) as being unpatentable over Dorobek in view of Mendelson ("Innovative Software GMBh: Java Booster"). Applicants submit that claims 1-35 as amended are patentable over the prior art of record.

Applicants' claim 1 is directed to a method that includes receiving a response from a plurality of catalog servers whose contents are provided and maintained by at least one external vendor. The method also recites that a catalog search is performed by each of the respective catalog servers. The Dorobek reference does not anticipate or render obvious a method in which catalog items on catalog servers, provided and maintained by at least one external vendor, are returned based on a search performed by the respective catalog servers.

The Dorobek reference is an article from Government Computer News, with a publication date of December 14, 1998. As referenced by the Examiner, the Dorobek reference discloses "demonstrat[ing] the ability to perform a search across multiple catalogs" (ninth

paragraph). The Dorobek reference describes a pilot program to test aspects of electronic commerce by integrating one or more catalogs. For example, the Dorobek reference discloses that "The pilot integrates three catalogs" (eighth paragraph). No reference or suggestion is made in the Dorobek reference to a method in which the plurality of catalog servers and catalog items contained therein are maintained by at least one external vendor. Moreover, the Dorobek reference does not disclose or suggest a method in which catalog items [are] identified in response to the request by a search performed by the corresponding catalog server. As such, it cannot be said that Applicants' independent claim 1 is rendered obvious by the Dorobek reference. Independent claim 1 is therefore patentable over the Dorobek reference.

Van Etten et al. discloses a procurement system that includes a requisition system for special item purchases that are not found when searching a catalog database. For example, Van Etten et al. discloses "Typically, a buyer accesses a standard buyer catalog database 32 that has been put together by his organization for routine purchases and that represent the purchasing preferences of the organization." (Col. 4, lines 54-57.) As with the Dorobek reference, no reference is made in Van Etten et al. that the catalog items are maintained by at least one external vendor. Moreover, Van Etten et al. does not disclose a plurality of catalog servers or that the catalog servers perform the catalog search.

Dan et al. discloses a method, apparatus, and computer implemented instructions for generating a customized catalog. As with the Dorobek reference and Van Etten et al., no reference is made in Dan et al. that a catalog item search is performed by external catalog servers.

The Mendelson reference is an article from PC Magazine, with a publication date of March 24, 1998. The Mendelson reference discloses fetching pages from a cache instead of from the Internet by changing a browser's proxy settings. As with the Dorobek reference, Van Etten et al., and Dan et al. no reference is made in the Mendelson reference that a catalog item search is performed by external catalog servers or that catalog items are maintained by at least one external vendor. Moreover, no reference is made in the Mendelson reference that an application server determines available catalog servers from the requestor's proxy settings.

Accordingly, Applicants request that the Examiner remove his obviousness rejection of independent claim 1, as well as the obviousness rejections of dependent claims 2-12 which each depend either directly or indirectly from claim 1.

With respect to the other independent claims 13 and 24, each of these claims recites machine-executable instructions or a system in which the plurality of catalog servers and catalog items contained therein are provided and maintained by at least one external vendor or where catalog items [are] identified in response to the request by a search performed by the corresponding catalog server. As such, Applicants request the Examiner remove his obviousness rejection of these claims as well.

Conclusion

Applicants submit that the claims 1-35 as amended are in condition for allowance, and requests favorable consideration of these claims.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Please apply $ 460 for the extension fee any other charges or credits to deposit account 06-1050.

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Respectfully submitted,

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